

REMARKS

The Examiner, in the Restriction Requirement dated June 4, 2002, has required that Applicants elect one of the following groups for prosecution in this application:

- I. Claims 29, 31 and 55-60, drawn to a semiconductor device, classified in class 257, subclass 678+; or
- II. Claims 36-38 and 49-54, drawn to a method of making a semiconductor device, classified in class 438, subclass 106+.

The Examiner justifies the requirement by stating that the claims of Group I and Group II are related as process of making and product made, wherein the process includes encapsulating the chip with a resin but the device claims do not require encapsulation. The presently added claims 61 and 62 are directed to semiconductor devices having all of the features of claims 29 and 31 respectively, and the additional feature of an encapsulant resin that encapsulates the support member, the semiconductor chip and the attaching member as supported by the specification (page 4, lines 13-16, and page 17, line 7 to page 18, line 8) and by Figure 1(e) of the instant application. Applicants assert that the present amendment adds no new matter to the application.

In compliance with 37 C.F.R. 1.143, Applicants elect to further prosecute the subject matter of Group II, claims 36-38 and 49-54. Applicants also assert that new claims 61 and 62 are linking claims that should be examined with the claims of Group II. The election is made with traverse. Applicants respectfully request reconsideration and withdrawal of the restriction requirement for the following reasons.

Applicant believes that the Examiner's restriction/election requirement does not comply with the requirements for a proper restriction as stated in the USPTO guidelines set out in the Manual of Patent Examining Procedure.

There are several criteria for a proper requirement for restriction between independent or patentably distinct inventions: (A) the inventions must be independent or distinct as claimed; and (B) there must be a serious burden on the examiner if restriction is required. MPEP §803, (7th Edition, July 1997). "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." *Id.* (Emphasis added.)

In the present case, the Examiner has already examined all claims on the merits, thus admitting that the examination of all claims imposes no serious burden on the Examiner. An Action in which claims 25-48 were all examined on the merits was issued on September 25, 2001. In a response to the September 25, 2001 Action dated June 20, 2001, applicants cancelled claims 25-28, 31, 36-38, and 49-60 and added new claims 49-60; however, new claims 49-54 merely incorporate the subject matter of claims 32-37 in claims dependent upon allowed claim 38, and new claims 55-60 merely incorporate the subject matter of claims 25-28, 30 and 31 in claims dependent upon existing claim 29. No new issues were raised by the Amendment.

Thus, the second requirement of the MPEP for a proper restriction requirement has not been met. There is simply no burden placed on the USPTO to examine claims already examined. According to the USPTO's own procedures, all claims must be examined together in a case such as the present one where there is no serious burden imposed.

Applicants additionally point out that new claims 61 and 62 are linking claims and have all of the features that would result from the method claims 36-38 and 49-54, which renders the Examiner's reason for the restriction requirement moot. However, in the event that the Examiner upholds the present restriction requirement, Applicants assert that new claims 61 and 62 should be examined with claims 36-38 and 49-54. When claims 61 and 62 are allowed, Applicants respectfully request that claims 29, 31 and 55-60 be rejoined to the subject matter of Group II as is properly described in MPEP § 809 and examined on the merits. So, even if the Examiner upholds the restriction requirement, the Examiner will be required to examine the subject matter of Group I when it is properly rejoined with the subject matter of Group II.

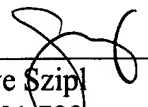
The imposition of a restriction requirement, on the other hand, would be wasteful of both the USPTO's and the applicants' resources, and unfairly burden the applicants. The requirement would require the USPTO to examine once again claims already examined, and would require the applicants to file another application for claims that should be examined together. In any event, new linking claims 61 and 62 render the restriction requirement superfluous because claim 38 has been allowed; therefore, when claims 61 and 62 have been allowed the Examiner will be required to rejoin the subject matter of Group I with Group II and examine the subject matter of Group I, as set forth in MPEP§ 809. Applicants

respectfully request an expedited and timely response to applicants' request for reconsideration of the restriction requirement so that the applicants may promptly file a petition to withdraw the restriction requirement in accordance with 37 C.F.R. 1.144, in the event that the Examiner upholds the restriction requirement.

It is believed that this application is now in condition for examination, and the Examiner's early and favorable consideration is earnestly solicited. Questions are welcomed by the below-signed attorney for Applicants.

Respectfully submitted,

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